

Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated April 6, 2004, indicated that the Specification is objected to for informalities; claim 11 is rejected under 35 U.S.C. § 112(2); claims 1, 2, 5-11, 13, and 16-20 are rejected under 35 U.S.C. § 102(e) over *Kelly* (U.S. Patent No. 6,377,568); claim 3 is rejected under 35 U.S.C. § 103(a) over *Kelly*; claim 4 is rejected under 35 U.S.C. § 103(a) over *Kelly* in view of *Langlais* (U.S. Patent No. 6,091,932); claim 12 is rejected under 35 U.S.C. § 103(a) over *Kelly* in view of *Beddus et al.* (U.S. Patent No. 6,654,457); claim 14 is rejected under 35 U.S.C. § 103(a) over *Kelly* in view of *Hooks et al.* (U.S. Patent No. 6,294,892); and claim 15 is rejected under 35 U.S.C. § 103(a) over *Kelly* in view of *Locascio* (U.S. Patent No. 6,603,757).

With respect to the Specification, Applicant has amended the objected-to paragraph to read more clearly and to correct the typographical error. Thus, Applicant requests that the objections to the Specification be removed.

Applicant respectfully traverses the Section 112(2) rejection because the claim language clearly indicates the claimed subject matter. Specifically, the Examiner asserts that the claim is indefinite because specific communications standards are not defined. There is no requirement that Applicant list specific standards in the claims, as communications standards are not required by claim 11. Applicant cites, as examples, page 5, lines 10-15, and page 7, line 13 *et seq.*, the SGCP/MGCP and H.323 communications standards; however, these specific examples are not required by the claim. Thus, Applicant contends that the scope of the claim is ascertainable and therefore requests that the Section 112 rejection be withdrawn.

Applicant respectfully traverses each of the prior art rejections (under Sections 102(e) and 103(a)), which rely on the '568 reference, because the Office Action fails to show how the '568 reference corresponds to the claimed invention. Specifically with respect to claim 1, the Office Action fails to identify a data gateway circuit including multiple data paths, as claimed. Figure 2 of the '568 reference shows each telephone connected to its own gateway, for example, telephone 214B connected to gateway 218A. The corresponding internet phone, 232B is then connected to an ISP and not gateway

218B; thus, each '568 gateway has a single path connected to one phone and does not have multiple circuit paths as claimed. Further, none of the elements of Figure 2 appear to have multiple circuit paths adapted to process audio information. The "multiple paths between elements of Figure 2" identified in the Office Action are not adapted to process the data. For the above reasons, Applicant fails to see how the cited portions of the '568 reference correspond to the limitations of instant claim 1 and without a showing of correspondence to each of the claimed limitations, the prior art rejections cannot stand. Applicant accordingly requests that each of the rejections be withdrawn.

With particular respect to claim 5, Applicant traverses the Section 102(e) rejection because the Office Action fails to present a (single) reference that corresponds to the claimed invention. The Office Action relies upon a general incorporation by reference in the '568 reference that includes the cited '121 reference. Long-standing patent law prohibits use of such a general incorporation by reference as a proper basis for specific hindsight construction of a claimed invention. A reference may be incorporated by reference for an identified and specific purpose. The '568 reference fails to indicate any specific purpose for incorporating the '121 reference (and many of the other co-listed references) or what teachings in these references are considered to be applicable to any of the '568 embodiments. As such, the Office Action's reliance upon the '121 reference is improper and fails to identify a (single) reference that teaches each of the claimed limitations. The Section 102(e) rejection of claim 5 is therefore improper and Applicant requests that the rejection be withdrawn.

With particular respect to claim 7, the Office Action's assertion that a computer system 1100 (presumable in the '121 reference) inherently contains a unit level assembly including the claimed PCB with its codec software in a housing is inappropriate because it is unsupported and readily refuted. The '121 reference at column 13, lines 5-12, clearly teaches that the illustrated system would apply to a mainframe (in which there would be multiple PCBs and no housing). In order to establish a rejection based on inherency, the Office Action must present extrinsic evidence that "must make clear that the missing descriptive matter *is necessarily present in the thing described in the reference*, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991) (emphasis added). The Office Action fails to present any of the requisite support for the

inherency assertion and the cited reference proves the assertion to be erroneous. Without support for the assertion of inherency, the rejection of claim 7 is improper and Applicant requests that the rejection be withdrawn.

With respect to the rejection of claim 20, Applicant cancels the claim without prejudice, thereby rendering the rejection moot. Applicant accordingly requests that the rejection be withdrawn.

The remaining claims depend from the above-discussed independent claims and are believed to be patentable for the reasons discussed above. Thus, Applicant requests that each of the Section 102(e) and 103(a) rejections be withdrawn.

In view of the above discussion, Applicant believes that the rejection has been overcome and the application is in condition for allowance. A favorable response is requested. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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